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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,723	01/29/2001	Peter G. Webb	10010016-1	1312

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AGILENT TECHNOLOGIES  
Legal Department, 51U-PD  
Intellectual Property Administration  
P.O. Box 58043  
Santa Clara, CA 95052-8043

EXAMINER

SMITH, CAROLYN L

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

9M.

**Advisory Action**

**Application No.**

09/772,723

**Applicant(s)**

WEBB, PETER G.

**Examiner**

Carolyn L Smith

**Art Unit**

1631

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 25 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-14.

Claim(s) withdrawn from consideration: 15-44.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 5. does NOT place the application in condition for allowance because: the arguments are unpersuasive, as discussed below. Applicant states a passage on page 10 of the specification and Figure 4 describes a feature of the invention to be a map of the identity of the individually identified vessels per se, and not just the biopolymers obtained therefrom, is obtained and printed onto the array substrate, in addition to the biopolymers. This statement is found unpersuasive, as the specification does not go into such details on page 10 as the Applicant suggests. Page 10 of the specification recites (as does claim 1 and 8) that a map of the identity of the vessels to the corresponding regions of the substrate onto which the biopolymers from respective vessels are deposited, in association with a map identifier. An identity of the contents of the vessel qualifies as an identity of the vessel. The specification or claims do not appear to suggest that this interpretation of "identity of the vessels" is improper. Applicant states that the phrase "the identity of the vessels" must be read in the specification. This is acknowledged; however, it is noted that the specification does not appear to have an explicit definition of this phrase. Therefore, this phrase can be reasonably and broadly interpreted to mean that an identity of the contents of the vessels is sufficient to represent an identity of the vessels themselves. Applicant states an there is an illustrative example where each feature is matched with a vessel identifier, which vessel identifier is not just an identity of the biopolymer in the vessel, but the identity of the vessel, per se. This is found unpersuasive as an illustrative example does not qualify as an explicit definition. Therefore, the illustrative example has no effect on preventing a broader yet reasonable interpretation of the phrase to be used by the Examiner. Applicant submits the Examiner is reading the present language of the claim more broadly than can be supported by the claim language. This statement is found unpersuasive as each term may be interpreted broadly and reasonable unless there is an explicit definition in the specification that would suggest otherwise. Applicant states that knowing a composition does not tell one anything about the identity of the source vessel of the composition. This is found unpersuasive. Referring back to strawberry jam alone sufficiently representing identification of a vessel or jar of strawberry jam, the strawberry jam identifies the source which is strawberries. Applicant states there is no teaching or suggestion in the combination of rejections to generate a map of the source vessels per se and associate it with the manufactured array. This statement is found unpersuasive as Applicants are interpreting the claims too narrowly, stating that the generation of a map of the source vessels per se. The claims can be broadly and reasonably interpreted to encompass more than the "vessels per se". Using the broad interpretation of the claim language, the references teach each limitation in the claimed invention, as fully described in the previous FINAL office action .

*Ardin H. Marschel 9/1/04*  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER